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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,266	06/07/2006	Hans Peter Weitzel	WAS0768PUSA	4695

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BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075

EXAMINER	
KOLLIAS, ALEXANDER C	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/596,266	WEITZEL ET AL.	
	Examiner	Art Unit	
	ALEXANDER C. KOLLIAS	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 May 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *34-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *34-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. All outstanding objections and rejections, except for those maintained below, are withdrawn in light of Applicant's Appeal Brief Filed 5/3/2010.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

3. It is noted that in the Final Action mailed on 12/03/2009, the rejection of claims 43 and 45 was inadvertently omitted. Further, it is noted that Paragraph 10, the grounds of rejection omitted claim 47 while Paragraph 13 the grounds of rejection inadvertently listed claim 47 when claim 46 should have been listed instead. Given the new grounds of rejection of claims 43 and 45 the following Action is therefore made non-final. Delay in prosecution is regretted.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 49, 34-43, and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Weitzel et al (2003/0018121).

Regarding claims 49 and 34-42, Weitzel et al discloses a composition comprising water re-dispersible polymer powder and biocides such as fungicides (Abstract, Page 1 [0009], Page 2 [0016], [0018], Page 3[0023]). The reference discloses that the polymer is mixed in an aqueous

dispersion and spray dried. In order to prepare the composition the powder is mixed in the form of a dispersion or powder (Page 3 [0023] Page 4 [0038]). Given that the reference discloses that additives such as biocides are mixed with the polymer powder in dry from, it is clear that that the biocide in is present in the water re-dispersible polymer powder composition, meeting the limitations recited in the claims 49. The amount of biocide added in the amount from 0.001 to 0.2 %, within the amount of 0.001 to 0.5 % presently recited in claim 33 (Page 3 [0028]). The reference discloses that the composition comprising the re-dispersible polymer and biocide comprises fillers such as calcium carbonate, silicates, talc, clays, quartz etc, thus it is clear that the reference meets the limitations drawn to a curable mineral construction product recited in the present claims (Page 3 [0030]). The reference discloses that the composition comprises a hydraulically setting miner binder such as lime and gypsum recited in claim 36 (Page 4, [0032]). Although the reference discloses that the composition may comprise inorganic binder such as cement, cement is not required thus meeting the limitations recited in claim 37 drawn to a curable construction product which is cement free. Regarding the biocides the reference discloses that the composition comprises biocides such as isothiazolinones such as dicloro-N-octylisothazolinone and benzimidazole derivatives, meeting the limitations recited in claims 38-40 (Page 3 [0028]). The reference discloses polymers such as homopolymer or copolymers comprising one or more monomers of vinyl esters, vinyl halides, methacrylate, 1,3-diene, vinyl-aromatic, olefin, and optionally further monomers (Page 1 [0009] and Page 2 [0015]). Additionally, the reference discloses copolymers such as vinyl acetate, ethylene, and a vinyl ester of alpha-branched monocarboxylic acid having 9 to 11 carbon atoms, or copolymers of styrene and one or more monomers such as methyl acrylate, ethyl acrylate, propyl acrylate, n-butyl

acrylate or 2-ethylhexyl acrylate (Pages 1-2 [0016]). Given that the reference discloses that the polymer has a glass transition temperature from -10 to 25 degree C, it is clear that the polymer is film forming (Page 2 [0015]).

Regarding the product by process limitations recited in claim 35, the reference discloses that the re-dispersible polymer powder is prepared by spray drying an aqueous dispersion comprising the polymer (Page 3, [0023]). As discussed above the reference discloses that the polymer powder in dry form in mixed with additives such as biocides (Page 4 [0038]). Therefore, the reference meets the limitations of spray drying an aqueous polymer dispersion to form a water re-dispersible polymer powder and the biocide is admixed in solid from with the water re-dispersible polymer powder recited in claim 35.

Although Weitzel does not disclose that the water re-dispersible polymer powder compositions is prepared by spray drying an aqueous polymer dispersion together with the biocide recited in claim 34, it is noted that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process", *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) . Further, "although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product", *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently claimed (process) and given that Weitzel meets the requirements of the claimed composition, (reference name) clearly meet the requirements of present claims.

Regarding claim 47, Weitzel et al teaches all the claim limitations as set forth above. Additionally, the reference discloses a process wherein the additives, including binders such as carbonates, lime gypsum and biocides are mixed with the re-dispersible polymer powder in dry form (Page 4 [0032] and [0038]). The dry mix is produced and water needed for processing is added prior processing (Page 4 [0038]). The amount of biocide added in the amount from 0.001 to 0.2 %, within the amount of 0.001 to 0.5 % presently recited in claim 47 (Page 3 [0028]). Given that the reference discloses that additives such as biocides are mixed with the polymer powder in dry from, it is clear that that the biocide in solid form is present in the water re-dispersible polymer powder composition, meeting the limitations recited in the claim 47.

Regarding claim 43, Weitzel discloses a process wherein the additives, including binders such as carbonates, lime gypsum and fungicides are mixed with a re-dispersible polymer powder in dry form (Page 4 [0032] -[0038]). The water redispersible polymer is obtained by spray drying (Page 3 [0023]). it is noted that in the process disclosed by the reference, the addition and mixing of the fungicide and redispersible polymer meets the limitations of admixing a polymer powder composition with a solid biologically active additives recited in the present claims.

In light of the above, it is clear that Weitzel et al anticipates the presently recited claims.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weitzel et al (2003/0018121).

The discussion with respect to Weitzel et al as set forth in Paragraph 5 above is incorporated here by reference.

Regarding claim 50, Weitzel teaches all the claim limitations as set forth above. Additionally, Weitzel discloses copolymers comprising a mixture of vinyl acetate, ethylene and a vinyl ester of α-branched monocarboxylic acid having from 9 to 11 carbon atoms. Although the reference does not explicitly disclose vinyl versatate, it is noted that vinyl versatate is vinyl ester tert-decanoic acid, and thus the above disclosure vinyl esters of α-branched monocarboxylic with 9 to 10 carbon atoms, encompasses vinyl versatate. Additionally, the reference discloses biocides such as N-octylisothazolione (Page 3 [0028]).

While the reference fails to exemplify the presently claimed composition nor can the claimed composition be "clearly envisaged" from the reference as required to meet the standard of anticipation (cf. MPEP 2 13 1-03), nevertheless, in light of the overlap between the claimed composition and the composition disclosed by the reference, absent a showing of criticality for the presently claimed composition, it is urged that it would have been within the bounds of routine experimentation, as well as the skill level of one of ordinary skill in the art, to use the

composition which is both disclosed by the reference and encompassed within the scope of the present claims an thereby arrive at the claimed invention.

8. Claims 34, 44-46, 48, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weitzel et al (2003/0018121) in view of Botts et al (US 7,070,795).

The discussion with respect to Weitzel et al as set forth in Paragraph 5 above is incorporated here by reference.

Regarding claims 34, Weitzel teaches all the claim limitations as set forth above. The reference teaches all the claim limitations as set forth above However, Weitzel et al does not disclose a process wherein water re-dispersible polymer powder composition is prepared by spray drying an aqueous polymer dispersion together with a biocide.

Botts et al discloses active ingredients such as fungicides or insecticides which are entrapped in a polymeric matrix to form particles. The particles when applied release active ingredients at a rate to provide effective amounts of the active ingredients over a period of time (Abstract, Column 7, Lines 36-60, Column 8, Lines 16-27, Column 12, Lines 30-55, Column 15, Lines 28-64). The reference discloses method of producing the matrix particles that comprise such as spray dying so that the active ingredient a distributed uniformly throughout the polymer matrix (Page 18, Lines 5-12).

Given that Weitzel et al discloses a compositions comprising water re-dispersible polymers and biocidal compounds and processes to spraying drying the re-dispersible polymer, in light of the particular advantages provided by the use and control of the spraying drying a polymer matrix with active ingredients as taught by Botts et al, it would therefore have been

obvious to one of ordinary skill in the art to include such sprayed dried polymer and method of production in the composition and methods disclosed by Weitzel et al in order to obtain polymer particles which have active compounds distributed uniformly throughout.

Regarding claim 44, Weitzel teaches all the claim limitations as set forth above. The reference teaches all the claim limitations as set forth above However, Weitzel et al does not disclose a process wherein water re-dispersible polymer powder composition is prepared by spray drying an aqueous polymer dispersion together with a biocide.

Botts et al discloses active ingredients such as fungicides or insecticides which are entrapped in a polymeric matrix to form particles. The particles when applied release active ingredients at a rate to provide effective amounts of the active ingredients over a period of time (Abstract, Column 7, Lines 36-60, Column 8, Lines 16-27, Column 12, Lines 30-55, Column 15, Lines 28-64). The reference discloses method of producing the matrix particles that comprise such as spray dying so that the active ingredient a distributed uniformly throughout the polymer matrix (Page 18, Lines 5-12).

Given that Weitzel et al discloses a compositions comprising water re-dispersible polymers and biocidal compounds and processes to spraying drying the re-dispersible polymer, in light of the particular advantages provided by the use and control of the spraying drying a polymer matrix with active ingredients as taught by Botts et al, it would therefore have been obvious to one of ordinary skill in the art to include such sprayed dried polymer and method of production in the composition and methods disclosed by Weitzel et al in order to obtain polymer particles which have active compounds distributed uniformly throughout.

Regarding claims 45-46, the combined disclosure of Weitzel and Botts disclose all the claim limitations as set forth above. As discussed above, Weitzel discloses a process of mixing biocides with a curable construction products, additionally, it is noted that the reference discloses biocides such as isothiaolinones ,i.e. N-octylisothiazoline, dichloro-N-octylisothazolinone, etc and benzimidazoles such as 2-(methoxycarbonylamino)-benzimidazole (Page 3 [0028]).

Regarding claim 48, Weitzel teaches all the claim limitations as set forth above. Additionally, the reference discloses biocides such as isothiazolinones such as dicloro-N-octylisothazolinone and benzimidazole derivatives (Page 3 [0028]).

The reference teaches all the claim limitations as set forth above However, Weitzel et al does not disclose a process wherein the biocides are incorporated into the water re-dispersible polymer powder by spray drying an aqueous polymer dispersion and a biocide.

Botts et al discloses active ingredients such as fungicides or insecticides which are entrapped in a polymeric matrix to form particles. The particles when applied release active ingredients at a rate to provide effective amounts of the active ingredients over a period of time (Abstract, Column 7, Lines 36-60, Column 8, Lines 16-27, Column 12, Lines 30-55, Column 15, Lines 28-64). The reference discloses method of producing the matrix particles that comprise such as spray dying so that the active ingredient a distributed uniformly throughout the polymer matrix (Page 18, Lines 5-12).

Given that Weitzel et al discloses a compositions comprising water re-dispersible polymers and biocidal compounds and processes to spraying drying the re-dispersible polymer,

in light of the particular advantages provided by the use and control of the spraying drying a polymer matrix with active ingredients as taught by Botts et al, it would therefore have been obvious to one of ordinary skill in the art to include such sprayed dried polymer and method of production in the composition and methods disclosed by Weitzel et al in order to obtain polymer particles which have active compounds distributed uniformly throughout.

Regarding claim 51, the combined disclosures of Weitzel and Botts teach all the claim limitations as set forth above. Additionally, Weitzel discloses copolymers comprising a mixture of vinyl acetate, ethylene and a vinyl ester of α-branched monocarboxylic acid having from 9 to 11 carbon atoms. Although the reference does not explicitly disclose vinyl versatate, it is noted that vinyl versatate is vinyl ester tert-decanoic acid, and thus the above disclosure vinyl esters of α-branched monocarboxylic with 9 to 10 carbon atoms, encompasses vinyl versatate. Additionally, the reference discloses biocides such as N-octylisothazolione (Page 3 [0028]).

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 49, 34-35 and 37-46 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-3, 5, 11-13, 15, and 17 of U.S. Patent No. 6,740,692. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

Claims 1-3, 5, 11-13, 15, and 17 of U.S. Patent No. 6,740,692 recite a water re-dispersible polymer powder composition comprising a fungicide, re-dispersible polymer comprising vinyl ester monomers or copolymers comprising vinyl acetate, ethylene and vinyl esters of alpha-branched monocarboxylic acids having from 9 to 11 carbon atoms. Additionally, the claims recite a biocide such as isothiazolinones which are added in the amount from 0.001 to 2 % by weight. While 6,740,692 does not claim the particular isothiazolinones, note that Col. 5, Lines 63-67 and Col. 6 Lines 1-10 which states that the composition comprises isothiazolinones such as N-octylisothiazolinone, dichloro-N-octylisothiazolinone, etc and benzimidazole. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

11. Claims 49, 33-35, and 37-46 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,740,692. Specifically, see the discussion as set forth in Paragraph 15 above.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). Specifically, see the discussion as set forth in Paragraph 9 above.

12. Claims 49, 33-35, and 37-46 are directed to an invention not patentably distinct from claims 1-3, 5, 11-13, 15, and 17 of commonly assigned patent. Specifically, the discussion set forth in Paragraph 15 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 6,740,692, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as

prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Response to Arguments

13. Applicant's arguments filed 9/9/2009 have been fully considered but they are not persuasive.

14. Applicants argue that the term "active compound" recited in the present claims is different from the complexed biocidal compounds disclosed by Weitzel. Further, Applicant argues that the term "active" is a term of art which means the bactericide, fungicide or algicide itself, i.e. neat with no further additives. As evidence of their position Applicants have filed a Declaration under 37 C.F.R. 1.132 on 9/9/2009. However, it is significant to note the following regarding the term "active":

The present disclosure, as originally filed, on Page 2 Lines 32-34 discloses that the composition comprises biocidal compounds, i.e. biocides, or biological active additives are

bactericides, fungicides and algaecides. Other than this disclosure in present Specification, there is no specific disclosure that Applicant's definition of a biologically active compound is a pure or unmodified compound.

Further it is noted that the Declaration on Page 2 (under bullet-point 6) simply states that the term "active" as used in the art refers to the active ingredient itself" and thus the complex disclosed in Weitzel is not an "active" given that the active compound in the reference is a fungicide complexed with cyclodextrin. However Applicants have not provided, other than argument, any evidence that in fact "active" in the art pertains to pure or uncomplexed biocidal compounds, and does not encompass complexed biocidal compounds.

In the Declaration the Applicants argue that the claims require "at least one biological additive consisting of.." in an attempt to limit the active compound to pure uncomplexed compounds. However, this appears to be a misinterpretation of the phrase "at least one biocidal additive selected from the group consisting of.." recited in claims49. It is clear from the claim construction/language that "consisting of" is a part of a Markush group and does not limit the biocide to that within the scope of an uncomplexed or pure biocidal compound.

Further it is significant to note that Applicants have stated (see Page 7 of the Appeal Brief) that the active is the compound which is complexed with cyclodextrin. Therefore given that Weitzel et al discloses an active complexed with cyclodextrin, it is clear that fungicides disclosed by the reference is the active compound.

Applicant argues that a cyclodextrin complex of an active contains an ingredient, cyclodextrin, which is not permitted by the "consisting of" language the Markush group. However, the Examiner reiterates that nothing in the scope of claims prohibits the biocide from

being complexed. To that end regarding claim 50 which recites the phrase "the biocide consists of, it is noted that the fungicide disclosed by Weitzel et al tautologically must consist only of itself. In other words, the reference does not disclose a biocide containing a mixture of biocides. Rather the reference discloses a single biocide, ,i.e. a biocide consisting of N-octylisothiazolinone.

Finally, it is noted that nothing within the scope of the present claims or a definition in the present Specification as originally filed, either limits the biocidal compound to a pure compound or excludes biocides complexed with cyclodextrin as taught by Weitzel.

15. Applicants argue that Weitzel et al does not disclose a redispersible polymer composition containing a biocide. However, it is firstly noted that the reference discloses mixing of redispersible polymer powder with active ingredients to form the composition. Further it is noted than there is nothing in the scope of the present claims that excludes mixing the redispersible polymer powder. It is noted that the process claims only require admixing of all the ingredients and doe not require that the biocide is contained within, attached to, etc to redispersible polymer powder.

16. Applicants argue that Boots teaches dissolving polymer and biocide to a solution, emulsifying the solution followed by spray drying, which is not the process presently claimed. Further, Applicants argue that in the presently claimed process a dispersion of solid particle and biocide are spray dried. However, attention is directed to claims 34 and 44 which recite that "the water redispersible polymer powder is prepared by drying an aqueous polymer dispersion

together with said biocide". The claim merely recites a process of spay drying a biocide and an "aqueous polymer dispersion" and does not require that the polymer is in a particular state, i.e. dissolved as taught by Botts or in solid form. That is, "aqueous polymer dispersion" encompasses both dissolved polymer in solution and a solid polymer in water, as long as the polymer is "dispersed" with the aqueous liquid. Thus, claims 34 and 44 do not require that the redispersible polymer powder is in solid form but rather that the polymer is dispersed or dissolved in water.

17. With respect to Applicants' arguments that it is well known for a polymer to be redispersible polymer powder, the polymer must exist in solid particular form prior to spray drying. It is noted that the no evidence to record has been provided that a redispersible polymer must be in solid form prior to spray drying However, it is noted that "the arguments of counsel cannot take the place of evidence in the record", *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments provided by the applicant regarding redispersible polymers must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001".

18. With respect to Applicants arguments that Botts does not employ a protective colloid which is necessary to from a redispersible polymer powder it is noted that the use of protective colloids is not recited in the present claims. In response to applicant's argument that the

references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., protective colloids) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

19. Applicants argue that claim 47 requires a biocide with a redispersible polymer powder. However it is noted that claim 47 recites, and Applicants admit on the record, that the claim 47 only requires mixing. The claim requires mixing building components water, and a redispersible polymer powder composition comprising a redispersible polymer power and a biocidal active.

20. Applicants argue that dispersion by definition is composed of a solid dispersed phase while an emulsion requires a dispersed liquid. It would appear that Applicants are conflating these two definitions. Dispersion encompasses both solid and liquid (solution) forms of a substance, as long as the substance is dispersed in a liquid medium. With respect to "emulsion" it is firstly noted that an emulsion encompasses both solid and liquid dispersed components, as long as there are two phases, e.g., latex which contains a solid dispersed polymer (solid phase) and an aqueous phase (liquid phase). That is, an emulsion is a specific form of dispersion, i.e. the term "dispersion" encompasses by definition an emulsion which must necessarily be dispersed.

21. With respect to Applicants' arguments that it is well known that for a polymer to be redispersible polymer powder, the polymer must exist in solid particular form prior to spray

drying. It is noted that the no evidence to record has been provided that a redispersible polymer must be in solid form prior to pray drying However, it is noted that "the arguments of counsel cannot take the place of evidence in the record", *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments provided by the applicant regarding redispersible polymers must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001".

22. Regarding the unexpected results in the Declaration, as cited in MPEP 706.02(b), it is noted that a rejection based on 35 USC 102(b), can only be overcome by (a) persuasively arguing that the claims are patentably distinguishable from the prior art, (b) amending the claims to patentably distinguish over the prior art, or (c) perfecting priority under 35 USC 119(e) or 120. As can be seen, comparative data is not sufficient to overcome an anticipatory rejection under 102(b).

23. Applicants argue that the difference between claim 49 and Wetzel is that the present claim is drawn to a biocidal additive which is "selected from the group consisting of bactericide actives, fungicide actives and algicide actives" (i.e. a recitation in Markush format) whereas Weitzel discloses an active biocide "in a host cavity" which, according to Applicant, is outside the scope of the "actives" recited in the claim. This argument is unpersuasive given that nowhere in the original disclosure is there any indication that said "actives" are so defined as to

exclude a host cavity or any other medium. Indeed, it is proper to hold that as along as Wetzel discloses a biocidal additive that functions as an "active" ingredient, regardless of the presence of any other moiety such as a host cavity, provided that said moiety does not adversely affect the activity of the "active" (and there is no evidence that such is the case here), then Wetzel's biocidal additive meets the corresponding additive in recited in the present claims.

24. Applicants argue the double patenting rejection of the present claims over claims 1-3, 5, 11-13, 15, and 17 of U.S. Patent No. 6,740,692 (US '692) as set forth in Paragraph 15-17 of the previous Office Action by comparing Example 6 and comparative Example 8 of US '692; Example 6 contains an uncomplexed biocide while comparative Example 8 of contains a neat and complexed biocidal compounds, respectively. However, as discussed above, the present claims do not exclude in any way the use of complexed or uncomplexed biocidal compounds but rather broadly recites that the composition comprises a water redispersible polymer power and at least one biocidal additive selected from the group consists of bactericide active(s), fungicide active(s) and algicide active(s). In light the language in the present claims and the discussion set forth above, the double patenting rejection of the present claims over US '692 is maintained.

25. Applicants argue that the double patenting rejection of the present claims over the claims in US 6,740,692 is improper given that US '692 requires complexed biocidal compounds, however, as discussed above, there is nothing in the scope of the present claims to prohibit or exclude the biocidal compound from being complexed.

Further, Applicants argue that the showing of unexpected results have not been properly considered. Specifically, Applicants argue that if side by side comparison were to be made, the microbial growth would have been much higher as evidenced by the data present in the Declaration. However, it is noted that the US '692 already recognizes the criticality of the claimed amounts of biocide of 0.01 to 0.5 wt % given that the reference recited a composition comprising 0.001 to 2 wt % biocide. Therefore the data in the Declaration is not found to be persuasive.

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER C. KOLLIAS whose telephone number is (571)-270-3869. The examiner can normally be reached on Monday-Friday, 8:00 AM -5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. C. K./
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796